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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|--------------------------|-------------|----------------------|---------------------|------------------|
| 10/718,852 | 11/20/2003 | Natasha P. Hixon | 2916-4842. 1US | 1905 |
| 24247 | 7590 | 10/17/2005 | EXAMINER | |
| TRASK BRITT | | | CHOI, STEPHEN | |
| P.O. BOX 2550 | | | | |
| SALT LAKE CITY, UT 84110 | | | ART UNIT | PAPER NUMBER |
| | | | 3724 | |

DATE MAILED: 10/17/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

| | | |
|------------------------------|--------------------------|------------------|
| Office Action Summary | Application No. | Applicant(s) |
| | 10/718,852 | HIXON ET AL. |
| | Examiner Stephen Choi | Art Unit 3724 |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 01 August 2005.
- 2a) This action is FINAL. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1-77 is/are pending in the application.
 - 4a) Of the above claim(s) 1-47 and 49-60 is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 48 and 61-77 is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on 20 November 2003 is/are: a) accepted or b) objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 - a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) Notice of References Cited (PTO-892)
- 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.

- 4) Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) Notice of Informal Patent Application (PTO-152)
- 6) Other: _____.

DETAILED ACTION

Election/Restrictions

1. Applicant's election without traverse of Group 14 in the reply filed on 01 August 2005 is acknowledged.

Response to Amendment

2. The declaration under 37 CFR 1.132 filed 06 August 2004 has been considered but is ineffective to overcome the Gaspari, Ehlscheid, and Sabin references. Gaspari, Ehlscheid, and Sabin references are a statutory bar under 35 U.S.C. 102(b).

Claim Rejections - 35 USC § 112

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 64-68 and 70 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 64, is "a support" in addition to "support" recited in claim 63?

In claims 65 and 70, "said surface of said substantially planar plate" lacks positive antecedent basis.

In claim 68, "said distance" and "said surface of said substantially planar plate" lack positive antecedent basis.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claims 48, 61-62, 68, 75, and 77 are rejected under 35 U.S.C. 102(b) as being anticipated by Gaspari (US 3,469,488).

Gaspari discloses all the recited elements of the invention including a portable, substantially rigid, substantially planar plate (11) including a back side (at 12) and at least one cutting edge (14, 14a) protruding from a front side/surface of the substantially planar plate. Regarding claim 68, col. 4, lines 17-22.

7. Claims 48, 61-67, and 77 are rejected under 35 U.S.C. 102(b) as being anticipated by Sabin (US 5,172,622).

Sabin discloses all the recited elements of the invention including a portable, substantially rigid, substantially planar plate including a back side (30) and at least one cutting edge (32) protruding from a front side/surface of the substantially planar plate. Regarding claim 63, a substantially rigid support (22). Regarding claim 64, as best understood, the support formed from a material softer than the material of the cutting edge (col. 4, lines 38-41). Regarding claims 65-67, as best understood, at least one ejection element comprising at least one compressible, resilient member (33, Figure 5).

8. Claims 48, 61-62, 68-70, and 75-76 are rejected under 35 U.S.C. 102(b) as being anticipated by Ehlscheid et al. (US 4,537,588).

Ehlscheid discloses all the recited elements of the invention including a portable, substantially rigid, substantially planar plate including a back side (1) and at least one cutting edge (1a) protruding from a front side/surface of the substantially planar plate. It

is noted that the plate can be configured to be secured to a portable die cutting apparatus. Regarding claims 68-69, col. 3, line 27 (0.2 mm is about 0.01 inch). Regarding claim 70, col. 3, line 32. Regarding claim 75, the plate has dimensions for compact and portable storage. Regarding claim 76, col. 1, lines 44-47.

Claim Rejections - 35 USC § 103

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. Claims 71-74 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gaspari or Ehlscheid.

Gaspari or Ehlscheid discloses the invention substantially as claimed except for peripheral dimensions of the plate of about 2 inches by about 2 inches. One having ordinary skill in the art would have been motivated to make the plate having different peripheral dimensions (e.g., 2" x 2") as taught by applicant's admitted prior art in order to accommodate sizes of indicia desired or sizes and shapes of cutouts desired. A change in size is generally recognized as being within the level of ordinary skill in the art. *In re Rose*, 105 USPQ 237 (CCPA 1955). It is noted that the common knowledge or well-known in the art statement of the previous office action has been taken to be admitted prior art because applicant either failed to traverse the examiner's assertion of official notice or that the traverse was inadequate.

Response to Arguments

11. Applicant's arguments filed 06 August 2004 with respect to the reference to Ehlscheid have been fully considered but they are not persuasive.

Applicants contend that Ehlscheid does not teach "a substantially rigid, planar plate" since a die of Ehlscheid is 8 mils thick, which would be relatively flexible and has a curvature and is bent to include two inwardly extending edges. Applicants further contend that Ehlscheid does not teach the die configured be secured to a portable die cutting apparatus. In addition, applicants argue that Ehlscheid is limited to dies that have cutting edges with height of 0.012 inch, not the "about 0.015 inch to about 0.02 inch" height.

Ehlscheid teaches a plate thickness of **about 0.2 mm**, which is **about 0.01 inch** that is a thickness of applicant's claimed plate. Thus, if applicant's plate is substantially rigid, so is Ehlscheid's plate. Furthermore, Ehlscheid teaches the plate that is planar prior to bending (see col. 3, lines 38-41). In addition, the die of Ehlscheid can be configured to be secured to a portable die cutting apparatus. Moreover, a height of **about 0.3 mm** is **about 0.015 inch**.

Conclusion

12. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within

TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Stephen Choi whose telephone number is 571-272-4504. The examiner can normally be reached on Monday-Thursday 9:00-5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Allan Shoap can be reached on 571-272-4514. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

sc
13 October 2005



STEPHEN CHOI
PRIMARY EXAMINER